

Remarks

Applicant appreciates the Examiner's thorough examination of the present application.

Applicant submits that the double patenting rejection does not stand based on the claims as amended herein. Applicant believes that the claims set forth in the present Response are patentably distinct from the claims set forth in U.S. Patent No. 7,591,218. Applicant requests reconsideration of the double patenting rejection by the Examiner. Should the Examiner still consider the amended claims to be patently indistinct, Applicant will reconsider filing a terminal disclaimer. If after review and acceptance of this Response, the Examiner believes that a double patenting rejection is still sustainable, Applicant respectfully requests that the examiner contact the undersigned attorney by telephone to discuss this rejection and expedient submission of a terminal disclaimer, if necessary.

Rejection Under 35 U.S.C. §102 (e)

Claims 1-5, 11 and 12 have been rejected under 35 U.S.C. §102(e) based on the Klaassen reference. Applicant respectfully requests favorable reconsideration of the present applicant in view of the amendments set forth herein, withdrawal of the rejection and allowance of claims 1-5, 11 and 12.

Claims 1, 2, 5-8, 11 and 12 have been rejected under 35 U.S.C. §102(e) as being anticipated by Klaassen. Applicant respectfully asserts that the claims as amended herein overcome and are allowable over this rejection.

The Klaassen reference shows a brewer which includes a screen which can be placed over brewing substance. The Klaassen reference does not include a cover which engages inside the cavity of the brewing substance holder. Additionally, the device

defining the cavity and which retains brewing substance in the Klaassen reference does not appear to be moveable. Rather, Figure 3 shows a user placing one of the devices in the brewer without removing a holder or container for attachment thereto. Additionally, Klaassen shows the use of a two piece system as a substitute for a pouch filled with ground coffee, commonly referred to as a pod.

With regard to the rejection under 35 U.S.C. §102, it is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Manufacture Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a particular prior art reference and arranged as in the claims. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH*, see *American Hoist and Derrick Company*, 221 USPQ481, 485 (Fed. Cir. 1984). Furthermore, in a rejection under 35 U.S.C. §102 (b) there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001,1010 (Fed. Cir. 1991).

As disclosed in the amended claims, the present invention includes a cover which is engaged inside the cavity of the brewing substance container. The container or holder of the claimed invention is removably attachable to the brewer. Additionally, the claimed invention is directed to a cover engageable inside the cavity of the brewing substance holder or container. In other words, there is no requirement to provide a separate bottom portion as required in Klaassen. The claimed invention includes this permeable portion with the body for use with loose coffee as well as pods.

In contrast, as noted above, Klaassen reference is deficient since it does not include each and every element of the amended claims.

For the foregoing reasons, Applicant respectfully asserts that the amended claims overcome and are allowable over the rejection under 35 U.S.C. §102. Applicant respectfully requests that the Examiner withdrawal the rejection and allow the claims.

Rejection Under 35 U.S.C. §103 (a)

With regard to the rejections under 35 U.S.C. §103(a), the rejections of the claims are primarily dependent on Klaassen as the primary reference. As such, if the Klaassen reference fails to provide support for a rejection of the amended claims, the other reference, NL-1020835, cannot provide the missing support. Logically, the failure of the Klaassen reference to provide the primary support will result in failure of the NL-1020835 reference to support the rejections.

Applicant refers to the arguments set forth above relating to the deficiencies of the Klaassen reference with regard to the rejection under 35 U.S.C. §102. While applicant is not arguing the same legal basis for the failure of the rejection under 35 U.S.C. §102, Applicant believes that all of the structural, functional, and technical discussion relating to the deficiencies of the Klaassen reference apply to the rejection under 35 U.S.C. §103.

Applicant reasserts the arguments with regard to Klaassen provided above.

Claims 3, 4, 9, 10, 13 and 14 were rejected based on the combination of Klaassen and NL-1020835.

Applicant refers to the arguments set forth above with regard to the Klaassen reference. Applicant reasserts the arguments with regard to Klaassen as applied to the rejection under 35 U.S.C. §103.

The additional reference identified as NL-1020835 does not provide any information which would overcome the deficiencies of the Klaassen reference as identified above. For the foregoing reasons, Applicant respectfully asserts that both Klaassen and the NL-1020835 reference provide support for the rejections under 35 U.S.C. §103.

Further, with regard to the rejections under 35 U.S.C. §103 (a), it is respectfully submitted that applicants claims are patentable, as the Examiner has failed to establish a

prima facie case of obviousness. According to section 706.02 (j) of the MPEP the Examiner must meet three basic criteria to establish a *prima facie* case of obviousness:

- (1) first, there must be some reasonable suggestion or motivation in the prior art to modify the reference or to combine the reference teachings;
- (2) second, there must be reasonable expectation of success in obtaining the claimed invention based upon the references relied upon the Examiner; and
- (3) third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

MPEP Section 706.02(j) further requires that the teaching or suggestion to make the modification or reference combination and the expectation of success, must be found in the prior art, and may not be based upon the applicants disclosure.

Neither of the references provides any suggestion or motivation to combine to achieve the claimed invention. Rather, a combination of the two cited references either teaches away from the claimed invention or are redundant.

There is no reasonable expectation of success in obtaining the invention set forth in the amended claims based on the cited references. Neither reference provides a handle or a cover which is engageable in the cavity. The cited prior art references, relying primarily on Klaassen do not teach nor suggest all the claimed limitations.

Applicant respectfully asserts that the Klaassen reference fails as a primary reference to support the rejections under 35 U.S.C. §103. Failure of the Klaassen reference results in failure of the rejection since there is no support for combination with the other cited reference. The other cited reference does not satisfy the missing limitations not found in Klaassen. With the foregoing in mind, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. §103.

Furthermore, the amendments to the claims are fully supported by the specification and the drawings as originally filed and do not add any new matter. For the foregoing reasons, Applicant respectfully asserts that claims 1- 5 and 7 -16 are in condition for

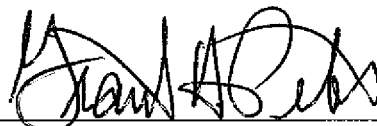
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Attorney Docket No. 27726-103081

allowance based on the amendments herein and as such, allowance is, respectfully requested.
Favorable reconsideration of the claims as amended herein is respectfully requested.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Applicant herewith Petitions for an Extension of Time. It is requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response with the fee for such extensions and any other fees or shortages in other fees, being charged, or any overpayment in such fees being credited, to the Deposit Account of Barnes & Thornburg LLP, Deposit Account No. 12-0913 acknowledging attorney docket no. (27726-103081).

Respectfully submitted,
BARNES & THORNBURG LLP



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